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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,798	09/29/2004	Kazuhito Miyake	Q83932	9654

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/509,798	Applicant(s) MIYAKE ET AL.	
	Examiner Richard L. Schilling	Art Unit 1752	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9-29-04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "n" is undefined.

2. Claims 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9-8-05.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-8 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Imamura et al. Imamura et al. (see particularly col.7, lines 26-68 ; col.10, lines 1-11 ;

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Ex. 1-4) disclose thermal transfer donors with light-heat conversion layers with binders of polyamide resins partially converted to imide.

4. Claims 1, 2, 4-7 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiriata et al. Kiriata et al. (col. 3, lines 5-55 ; col. 8, line 55- col. 9, line14; Ex. 3) discloses polyamide imide resin binders for light-heat conversion layers in thermal transfer donors.

5. Claims 1, 2, 4-8 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-348438. JP 11-348438 discloses thermal transfer donors with light-heat conversion layers with binders of polyamide imide resins as disclosed in the submitted translated PCT Examination Report.

6. Claims 1-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake et al., Wachi et al. or JP 11-334231 all in view of Arai et al., Kiriata et al. and JP 11-348438. Wachi et al. (see particularly paragraphs 40-49, 59; Ex. 1), Miyake et al. (see particularly col. 8, lines18-65; Ex. 1) and JP 11-334231 (abstract) disclose thermal transfer donors with light-heat conversation layers with binders, including polyamides and polyimides, and light absorbers, including cyanine dyes, used to make multicolor images on receivers. Arai et al. (see particularly col. 8, line 45- col.9, line23) teaches the use of polyamide-imide resins and their functional equivalence to polyamides or polyimides as binders for light-heat conversion layers in thermal sensitive elements. JP 11-348438 and Kiriata et al. (col.3, lines 5-55; col. 8, line 55- col. 9, line14) teach using polyamide-imide resins as binders for light-heat conversion layers in thermal transfer donors. Since polyamide-imide resins are taught in the art as suitable

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binders for light-heat conversion layers in thermal sensitive elements, including thermal transfer elements, it would be obvious to one skilled in the art to use polyamide-imide resins as the called for binders in the thermal sensitive transfer donors of Wachi et al., Miyake et al. or JP 11-334231.

7. Claims 1,3-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachi et al., Miyake et al. or JP 11-334231 all in view of Imamura et al. As explained in paragraph 6 above Wachi et al., Miyake et al. and JP 11-334231 disclose thermal transfer donors with light-heat conversion layers with resin binders and absorbers including cyanine dyes. Since Imamura et al. (col. 7, lines26-68 ; col. 10, lines1-11) teaches using polyamide resins partially converted to polyamide as binders for light-heat conversion layers in thermal transfer donors for their properties of high heat resistance and coatability, it would be obvious to one skilled in the art to use the polyamide with polyimide resins of Imamura et al. as the called for resin binders for the light-heat conversion layers in Wachi et al., Miyake et al. or JP 11-334231 for high heat resistance and better coatability as compared to polyimide.

8. Nakamura et al '418 is cited of interest as disclosing thermal transfer donors for making multicolor images of high resolutions.

9. Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 460-1752

